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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,252	03/08/2001	Makoto Ono	JP920000032US1 (590.050)	5562
35195	7590	02/10/2005	EXAMINER	
FERENCE & ASSOCIATES 400 BROAD STREET PITTSBURGH, PA 15143			NEURAUTER, GEORGE C	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/802,252

Applicant(s)

ONO, MAKOTO

Examiner

George C. Neurauter, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-7 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 05252004, 10272003.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION

Claims 1-7 are currently pending and have been examined.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35

U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2 and 3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 2 and 3 recite the limitation "transmitting to said user...not only [a] license key but also a program for disabling at least a part of the function of said downloaded". This limitation is not described in the specification to enable to skilled in the art to make or use the invention.

The following is a quotation of the second paragraph of 35

U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

For example, claims 1-3 recite the limitation "said preceding step". It is unclear as to what step is being referred to since the claims recite a plurality of preceding steps.

The claims, especially claims 2 and 3, are generally narrative and indefinite as indicated above. For example, claims 2 and 3 recite "transmitting...to said information terminal of said user a file downloading service menu or a menu that can be introduced into said file downloading menu". This limitation does not clearly show whether the file downloading menu is being transmitted or already has been transmitted based on the limitation "introduced into said file downloading means".

Claims 1-3, especially claims 2 and 3, are also unnecessarily repetitive, failing to conform with the distinctive criteria recited in 35 USC 112, 2nd paragraph. Claim 1 repeats the limitation "transmitting...a connection

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request..." Claims 2 and 3 also repeat limitations such as "activating a dialer...", "checking...[a] user ID and password", and "assigning...an IP address...". During the first recitation of these limitations, the claims recite the limitation "transmitting, when the results obtained by the check [of the user ID and password] are negative, a message to notify said user of a connection failure", however, during the second recitation, this limitation is omitted. It is unclear as to why the connection failure may be sent during the first recitation, but not during the second recitation. Therefore, these claims are not distinct and the Examiner requests that the claims be amended to distinctly claim the subject matter the Applicant regards as his invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for

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establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5 925 127 to Ahmad.

Regarding claim 1, Ahmad discloses an information distribution method for transmitting information to an information terminal connected via a network, comprising the steps of:

a user, who uses a network via a network provider under a condition of payment of a connection fee, transmitting a connection request from an information terminal of said user to said network provider ("logs on to Internet"; column 8, lines 54-57);

downloading a program from a server managed by said network provider, or by an entity that has a tie-up with said network provider; (column 8, lines 42-53; column 9, lines 45-49)

transmitting, to said information terminal of said user, either a license key that is referred to when said downloaded program is activated or executed and that disables at least a

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part of the function of said program when said program matches a predetermined license condition, or information with which said license key can be generated ("CICO module"); (column 9, lines 58-62; column 10, lines 21-34)

again transmitting, subsequent to said preceding step, a connection request that includes said user ID from said information terminal of said user to said network provider; and transmitting, to said information terminal of said user, either a new license key that is referred to when said downloaded program is activated or executed and that disables at least a part of the function of said program when said program matches another predetermined license condition, or information with which said new license key can be generated. (column 14, line 66-column 15, line 5)

Ahmad does not expressly disclose transmitting a connection request that includes a user ID from an information terminal of said user to said network provider.

Examiner takes Official Notice (see MPEP § 2144.03) that transmitting a user ID along with a connection request in a Internet network system was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the

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examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)."

Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

Claims 4-7 are also rejected since claims 4-7 recite an information distribution method, system, software product, and program storage device that recite substantially the same limitations as recited in claim 1.

Regarding claim 2, Ahmad discloses an information distribution method for transmitting information to an

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information terminal connected via a network, comprising the steps of:

a user, who employs a network via a network provider under a condition of payment of a connection fee, transmitting a connection request to said network provider; ("logs on to Internet"; column 7, lines 33-39; column 8, lines 54-57)

transmitting a service menu screen ("Internet site"), which is an initial screen, from said network provider to said information terminal of said user; transmitting, when said user selects a file for downloading an article on said service menu, a request for a connection with a file server from said information terminal of said user to said network provider; transmitting, when said file server receives said connection request, to said information terminal of said user a file downloading service menu or a menu that can be introduced into said file downloading service menu ("rental form"); transmitting, when said user selects the downloading of a desired file from said file downloading service menu, a file downloading request from said information terminal of said user to said network provider; (column 8, line 54-60; column 9, lines 38-44)

generating a license key ("licensing information"), based on specified downloaded program information ("program module"),

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that is associated with said desired file that is selected by said user and with said user ID that is specified for said IP address included in said file downloading request and assigned to said information terminal of said user, and information that is associated with a license condition for a downloaded program ("CICO module"); (column 9, lines 58-62; column 10, lines 21-34)

referring to said license key when said downloaded program is activated or executed, and transmitting to said user, when said program matches said license condition, not only said license key but also a program for disabling at least a part of the function of said downloaded program ("CICO module"); (column 9, lines 45-49; column 10, lines 21-34)

transmitting said downloaded program specifying information from said information terminal of said user to said network provider; and generating a new license key based on said user ID and said received downloaded program specifying information; and transmitting said new license key to said information terminal of said user. (column 14, line 66-column 15, line 5)

Ahmad does not expressly disclose wherein a user, who obtains a user ID and a password and employs a network via a network provider under a condition of payment of a connection fee, activating a dialer at said information terminal, entering said user ID, said password and a telephone number for accessing

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said network provider, and transmitting a connection request to said network provider; checking, upon the receipt of said connection request for said network provider, said user ID and said password that are included in said connection request; transmitting, when the results obtained by the check are negative, a message used to notify said user of a connection failure; assigning, when the results obtained by the check are affirmative, an IP address to said information terminal of said user, and registering a set consisting of said user ID and said correlated IP address; transmitting said IP address assigned for said information terminal of said user; and disconnecting said information terminal of said user from said network provider.

Examiner takes Official Notice (see MPEP § 2144.03) that using a dialer for entering a user ID, password, and telephone number for accessing a network provider using a modem, authenticating a user, sending a message of a connection failure, automatic assigning of an IP address known as DHCP, and disconnecting from a network provider in a Internet network system was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However,

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MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

Regarding claim 3, Ahmad discloses an information distribution method for transmitting information to an information terminal connected via a network, comprising the steps of:

a user, who employs a network via a network provider under a condition of payment of a connection fee, transmitting a connection request to said network provider; ("logs on to Internet"; column 7, lines 33-39; column 8, lines 54-57)

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transmitting a service menu screen ("Internet site"), which is an initial screen, from said network provider to said information terminal of said user; transmitting, when said user selects a file for downloading an article on said service menu, a request for a connection with a file server from said information terminal of said user to said network provider; transmitting, when said file server receives said connection request, to said information terminal of said user a file downloading service menu or a menu that can be introduced into said file downloading service menu ("rental form"); transmitting, when said user selects the downloading of a desired file from said file downloading service menu, a file downloading request from said information terminal of said user to said network provider; (column 8, line 54-60; column 9, lines 38-44)

generating a license key ("licensing information"), based on specified downloaded program information ("program module"), that is associated with said desired file that is selected by said user and with said user ID that is specified for said IP address included in said file downloading request and assigned to said information terminal of said user, and information that is associated with a license condition for a downloaded program ("CICO module"); (column 9, lines 58-62; column 10, lines 21-34)

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registering a user ID and said downloaded program specifying information with which said user ID is correlated; (column 9, lines 38-44)

referring to said license key when said downloaded program is activated or executed, and transmitting to said user, when said program matches said license condition, not only said license key but also a program for disabling at least a part of the function of said downloaded program ("CICO module"); (column 9, lines 45-49; column 10, lines 21-34)

searching for said downloaded program specifying information that is registered while correlated with said user ID; generating a new license key based on said user ID and said downloaded program specifying information that is found through said search; and transmitting said new license key to said information terminal of said user. (column 14, line 66-column 15, line 5)

Ahmad does not expressly disclose wherein a user, who obtains a user ID and a password and employs a network via a network provider under a condition of payment of a connection fee, activating a dialer at said information terminal, entering said user ID, said password and a telephone number for accessing said network provider, and transmitting a connection request to said network provider; checking, upon the receipt of said

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connection request for said network provider, said user ID and said password that are included in said connection request; transmitting, when the results obtained by the check are negative, a message used to notify said user of a connection failure; assigning, when the results obtained by the check are affirmative, an IP address to said information terminal of said user, and registering a set consisting of said user ID and said correlated IP address; transmitting said IP address assigned for said information terminal of said user; and disconnecting said information terminal of said user from said network provider.

Examiner takes Official Notice (see MPEP § 2144.03) that using a dialer for entering a user ID, password, and telephone number for accessing a network provider using a modem, authenticating a user, sending a message of a connection failure, automatic assigning of an IP address known as DHCP, and disconnecting from a network provider in a Internet network system was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of

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judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following prior art teaches information distribution methods and systems similar to those claimed:

US Patent 5 103 476 to Waite et al;

US Patent 5 138 712 to Corbin;

US Patent 5 375 206 to Hunter et al;

US Patent 5 826 000 to Hamilton;

US Patent 5 852 722 to Hamilton;

US Patent 5 859 969 to Oki et al;

US Patent 5 925 127 to Ahmad;

US Patent 6 012 088 to Li et al;

US Patent 6 460 140 to Schoch et al;

Droms R. et al. "Request for Comments (RFC) 2131: Dynamic Host Configuration Protocol", Network Working Group, March 1997.

Cornell University. "Dial-Up Networking on Windows 95 Computers at NYSAES", published 19 August 1998, <<http://www.nysaes.cornell.edu/cc/notes/366.pdf>>.

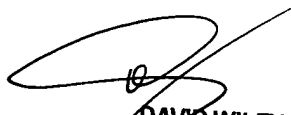
Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571) 272-3918. The examiner can normally be reached on Monday through Friday from 9AM to 5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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